

Docket No.: 50108-028

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Bruce CIOTTA

Serial No.: 09/695,213

Filed: October 25, 2000

For: MOBILE STATION INTERNET MESSAGING

: RESPONSE UNDER 37 CFR 1.116
: EXPEDITED PROCEDURE
:
: Customer Number: 20277
:
: Confirmation Number: 2316
: Group Art Unit: 2681
:
: Examiner: D. Q. Nguyen

PETITION FOR EXERCISE OF SUPERVISORY AUTHORITY
AND WITHDRAWAL OF FINALITY OF OFFICE ACTION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests that the Director exercise supervisory authority and instruct the Examiner to withdraw the improper finality of the February 12, 2004 Office Action in the above identified application. A detailed explanation of the basis of this request is set forth in the remarks, below.

REMARKS

Applicant submits that the Examiner improperly designated the latest Office Action as final. In the statement of finality (Office Action page 12), the Examiner cited M.P.E.P. §706.07(a) as the basis for making the present Office Action final and stated: "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." However, M.P.E.P. § 706.07(a) clearly states:

Furthermore, a second or any subsequent action on the merits in any application. .. **will not be made final** if it includes a rejection, **on newly cited art** ... of any claim **not amended by applicant** or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (emphasis added)

The Examiner applied U.S. Patent No. 6,677,968 to Appelman for the first time in the second Action against claims 1-9, 11, 13, 21 and 22, which have never been amended. In fact, the Appelman patent issued January 13, 2004, after the November 20, 2003 date of Applicant's response/amendment and could not have been cited or considered by Applicant in preparing that response. Similarly, claim 10 has not been amended, but it is rejected over a combination using both Appelman and U.S. Patent No. 6,636,502 to Lager et al. for the first time in the second Action.

Under M.P.E.P. § 706.07(a), the amendment of other claims in the response is not sufficient to make this second Action final. The finality of the February 12, 2004 Office Action therefore should be withdrawn. In a telephone interview on 2004, the undersigned pointed out the above-noted impropriety of the finality of the Office Action to Examiner David Q. Nguyen. However, Examiner Nguyen refused to withdraw the finality.

In the interview, the Examiner also asserted that Applicant's response had pointed out for the first time that the so-called 'Short Messaging' document cited in the first Action was not prior art in view of evidence presented in two Rule 131 declarations. This also is a clear error on

the part of the Examiner. The Rule 131 declarations were submitted with the application filing on October 25, 2000. The October 25, 2000 Information Disclosure Statement that cited the 'Short Messaging' document included an express assertion that the document was not "prior" art (see page 2). Hence, the Rule 131 declarations and the attendant fact that the 'Short Messaging' document was not "prior" art against the claims of this application was before the Examiner long prior to Applicant's November 20, 2003. Regardless of the Examiner's awareness or lack thereof of the evidence in the record, Applicant's assertion of a date of invention prior to the effective date (if any) of the 'Short Messaging' document can not serve as a basis for making the February 12, 2004 Office Action final.

In view of the Examiner's refusal to withdraw finality of the latest Action, Applicant's request that the Director exercise supervisory authority over the Examiner and withdraw the improper finality of the February 12, 2004 Office Action.

An amendment of the application is filed concurrently herewith. Upon withdrawal of the finality of the last Office Action, that amendment should be entered as a matter of right, and prompt favorable reconsideration is solicited.

Petition Fee/Request for Refund

Please charge the petition fee of \$130.00 (37 C.F.R. §1.17(h)) to Deposit Account 500417. However, in view of the impropriety of the finality and the Examiner's improper refusal to withdraw finality, it is believed that the need for this petition arose from clear errors on the part of the Office and through no fault of Applicant. As such, Applicant respectfully requests refund of the petition fee. The refund should be credited to said Deposit Account 500417

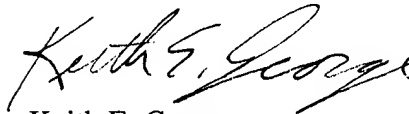
To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this

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paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in cursive script, appearing to read "Keith E. George".

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Date: April 8, 2004